

# Notice of Allowability

Application No.

09/967,238

Examiner

Frank W Lu

Applicant(s)

FU ET AL.

Art Unit

1634

## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 10/10/2004.
2. ☒ The allowed claim(s) is/are 1-17 and 26-28.
3. ☒ The drawings filed on 27 September 2001 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 12/2004.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

## **DETAILED ACTION**

### ***Reasons for Allowance***

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Ms. LeeAnn Gorthey (Reg. No. 37,337) on December 21, 2004.

2. The application has been amended as follows:

Cancel claims 18-25.

Replace "said first SID sequences on said duplexes and said second SID sequences on said duplexes" in lines 22 and 23 of claim 1 with --- said first SID sequences on said duplexes formed by the first probe with said selected sequence and said second SID sequences on said duplexes formed by the second probe with said selected sequence ---.

Replace "each said labeled decoder moiety" in claim 8 with --- said first or second labeled decoder moiety ---.

Replace "said each said decoder moiety" in claim 9 with --- said first or second labeled decoder moiety ---.

Replace "FACS" in line 3 of claim 10 with ---fluorescence-activated flow sorting (FACS) ---.

Replace "expressed genes of each of " in line 3 of claim 16 with --- expressed genes from ---.

Art Unit: 1634

Replace "populations of individuals" in line 4 of claim 17 with --- different populations of individuals ---.

Replace "step (ii)" in step (c) of claim 26 with ---(ii) ---.

Replace "FACS" in step (d) of claim 26 with ---fluorescence-activated flow sorting (FACS) ---.

Replace "said fluorescent labels" in step (d) of claim 26 with --- the fluorescent labels ---.

Replace "each said decoder moiety" in claim 28 with --- said first or second decoder moiety".

3. The following is an examiner's statement of reasons for allowance:

Claims 1-17 and 26-28 are allowable in light of the applicant's amendments filed on October 10, 2004 and the examiner's amendment. The closest prior art in the record is Lucas *et al.*, (US Patent No. 5,616,465) and Albrecht *et al.*, (US Patent No. 6,511,802 B1, filed on January 8, 1999). These prior art either alone or in combination with the other art in the record do not teach or reasonably suggest a method for determining the relative abundance of a nucleic acid sequence between first and second nucleic acid populations and a method for sorting a population of nucleic acid sequences in accordance with their relative abundance in first and second nucleic acid populations which comprises all of the limitations recited in claims 1 and 26.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Art Unit: 1634

4. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is either (571) 273-8300.

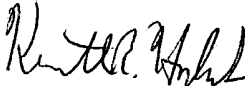
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746.

The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (571)272-0745.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.

Frank Lu  
PSA  
December 21, 2004

  
KENNETH R. HORLICK, PH.D.  
PRIMARY EXAMINER

12/22/04